

## **REMARKS**

### **Claim Rejections**

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Deal, III in view of Milligan and Feder.

### **Amendments to Specification**

Applicant has amended the specification as noted above to provide antecedent basis for reference number "35". It is believed that the foregoing amendments to the specification overcome the outstanding objections to the drawings. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

### **New Claims**

By this Amendment, Applicant has canceled claims 1-3 and has added new claims 4-6 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a facemask harness for a facemask comprising: a body (30) having a top protrusion (311) and two side protrusions (312, 313) extending outwardly in different directions from a center portion having a center opening (35), the top protrusion having a top strap (32) connected to a top of the facemask, each of the two side protrusions having a side strap (33, 34) connected to one of two opposing sides of the facemask, wherein the body includes an inner foam layer (301) connected to an outer elastic fabric layer (302).

Other embodiments of the present invention include: piping (314) formed from an elastic fabric fastened to an peripheral edge of the body with a stitching line (310), and each top strap and each side strap having a portion of a hook material (321, 331, 341) and a portion of a loop material (322, 332, 342) selectively engaging the hook material.

The primary reference to Deal, III teaches a protective face mask having a diamond shaped strap (68) including an upper band (66a) and a lower band (66b) with connecting segments (60a, 60b).

Deal, III does not teach a body having a top protrusion and two side protrusions extending outwardly in different directions from a center portion having a center opening; nor does Deal, III teach the body includes an inner foam layer connected to an outer elastic fabric layer.

The secondary reference to Milligan teaches a face guard and is cited for teaching a top strap (102).

Milligan does not teach a body having a top protrusion and two side protrusions extending outwardly in different directions from a center portion having a center opening.

The secondary reference to Feder teaches a diver's mask and is cited for teaching the combination of neoprene and an elastic fabric.

Feder does not teach a body having a top protrusion and two side protrusions extending outwardly in different directions from a center portion having a center opening; nor does Feder teach the top protrusion having a top strap connected to a top of the facemask.

Even if the teachings of Deal, III, Milligan, and Feder were combined, as suggested by the Examiner, the resultant combination does not suggest: a body having a top protrusion and two side protrusions extending outwardly in different directions from a center portion having a center opening.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Deal, III, Milligan, or Feder that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Deal, III, Milligan, nor Feder disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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By:

  
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